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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/890,832	11/09/2001	Patrice Vincent	Q65738	8154
7590	04/05/2005		EXAMINER	
Sughrue Mion Zinn Macpeak & Seas 2100 Pennsylvania Avenue NW Suite 800 Washington, DC 20037-3213			RAMANA, ANURADHA	
			ART UNIT	PAPER NUMBER
			3732	
DATE MAILED: 04/05/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/890,832	VINCENT, PATRICE	
	Examiner	Art Unit	
	Anu Ramana	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 March 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5, 7-9 and 12-18 is/are rejected.
- 7) Claim(s) 6, 10, 19 and 20 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 October 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 15, 2005 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 9 and 12-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Feingold et al. (US 5,772,666).

Feingold et al. disclose a one-piece lens injecting apparatus or device 10 having a syringe body 12 with a piston 18, a cylindrical portion 12a containing a preloaded lens in an undeformed state, a conical intermediate portion 12b and an injection end piece 24 wherein an injection end of the piston 18 has a plurality of plastic paddles or fingers 22g or 22n that flex together to form a cylinder that occupies practically an entire section of an end of the body (Figures 1 and 16; col. 2, lines 23-36 and lines 45-56; col. 6, lines 1-30; col. 7, lines 37-67, col. 8, lines 1-3 and lines 52-54 and col. 9, lines 25-34).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Feingold et al. (US 5,772,666), as applied to claim 1, in view of Blake (US 6,280,449).

Feingold et al. disclose all elements of the claimed invention except for a wedge-shaped central finger.

Blake teaches blades or fingers with different shapes to advance an implant through a syringe body (col. 12, lines 62-67 and col. 13, lines 1-27).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided an appropriately shaped (for e.g., wedge shaped) central finger, as taught by Blake, for the purpose of advancing an implant through a syringe body.

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feingold et al. (US 5,772,666), as applied to claim 1, in view of Lane (US 5,964,736).

Feingold et al. disclose all elements of the claimed invention except for sealing gaskets and a stopper.

Lane teaches Lane teaches a prefilled cartridge or "syringe" 48 wherein a twist off cap seal 52 is provided at one end and a plunger retention ring or sealing gasket 54 is provided at another end to prevent any internal pressure within the syringe 48 from forcing the plunger out of the syringe (Figs. 3, 4 and 8, col. 7, lines 9-27).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a twist off cap seal 52 at one end of the Feingold et al. apparatus and a sealing gasket 54 on the plunger of the Feingold et al. device, as taught by Lane, to seal the apparatus and prevent the plunger from moving out of the apparatus.

The combination of Feingold et al. and Lane disclose all elements of the claimed invention except for multiple sealing gaskets. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided more

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than one sealing gasket, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claim 8, Feingold et al. disclose that device 10 can be manufactured from structural grade plastic or metal to allow autoclaving thereof (col. 10, lines 34-37). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the device of the combination of Feingold et al. and Lane of materials capable of withstanding heat, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use, herein sterile use by autoclaving, as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feingold et al. (US 5,772,666), as applied to claim 1, in view of Figueroa et al. (US 5,873,879) and Lane (US 5,964,736).

Feingold et al. disclose all elements of the claimed invention except for sealing gaskets and a stopper.

Figueroa et al. teach providing O-rings or "sealing gaskets" 120a, 120b to enable a more controlled manual operation of a plunger (Fig. 2 and col. 5, lines 38-53).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided sealing gaskets or O-rings on the plunger of the Feingold et al. device, as taught by Figueroa et al., to enable a more controlled operation of the plunger.

Lane teaches a prefilled cartridge or "syringe" 48 wherein a twist off cap seal 52 is provided at one end to seal the contents of the syringe (Figs. 3, 4 and 8, col. 7, lines 9-27).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a twist off cap seal 52 at one end of the device of the combination of Feingold et al. and Figueroa et al., as taught by Lane, to seal the contents of the apparatus.

Regarding claim 8, Feingold et al. disclose that device 10 can be manufactured from structural grade plastic or metal to allow autoclaving thereof (col. 10, lines 34-37). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the device of the combination of Feingold et al., Figueroa et al. and Lane of materials capable of withstanding heat, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use, herein sterile use by autoclaving, as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 9 and 12-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 6, 7, 15, 20, 22 and 23 of copending Application No. 10/471,888. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims of the present application and the claims of the copending application is that the claims of the copending application include many more elements and are thus more specific. Thus the invention of the claims of copending application is in effect a "species" of the "generic" invention of the claims of the present application. It has been held that the generic invention is "anticipated" by

the "species." See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claims of the present application are anticipated by the claims of the copending application, they are not patentably distinct from the claims of the copending application.

Regarding claim 3, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the fingers of plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 5 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 5 of copending Application No. 10/471,888 ('888 herein) in view of Blake (US 6,280,449).

Claim 5 of '888 discloses all elements of the claimed invention except for a wedge-shaped central finger.

Blake teaches blades or fingers with different shapes to advance an implant through a syringe body (col. 12, lines 62-67 and col. 13, lines 1-27).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided an appropriately shaped (for e.g., wedge shaped) central finger, as taught by Blake, for the purpose of advancing an implant through a syringe body.

This is a provisional obviousness-type double patenting rejection.

Claims 7 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 10/471,888 ('888 herein) in view of Figueroa et al. (US 5,873,879) and Lane (US 5,964,736).

Claim 2 of '888 discloses all elements of the claimed invention except for a sealing gasket and a stopper.

Figueroa et al. teach a syringe body in which a lens 12 can be preloaded and shipped to a user in a suspended state and O-rings or gaskets 120 are provided on a plunger for controlled manual operation of the plunger (Fig. 13, col. 3, lines 17-28 and col. 4, lines 7-34).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided O-rings or gaskets on the plunger of the device of claim 2, as taught by Figueroa et al., for controlled manual operation of the plunger.

Lane teaches a prefilled cartridge or "syringe" 48 wherein a twist off cap seal 52 is provided at one end to seal the syringe (Figs. 3, 4 and 8, col. 7, lines 9-27).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a twist off cap seal 52 at one end of the device of the combination of Figueroa et al. and claim 2 ('888), as taught by Lane, to seal the contents of the device.

Regarding claim 8, Figueroa et al. teach that the device can be made of metal or a plastic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made the device of the combination of claim 2 ('888), Figueroa et al. and Lane of metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Response to Arguments

Applicant's arguments submitted under "REMARKS," in the response filed on March 15, 2005 have been fully considered but are not persuasive.

Applicant's arguments with respect to claims 1-5, 7-9 and 12-16 are not persuasive because they are not directed to claimed limitations.

The limitations "practically the entire section of an end of the body" or "substantially occupy an entire cross-section of the conduit" implies "nearly or almost the entire section of an end of the body" and do not preclude the presence of a space

between the fingers. Figure 11 of Feingold et al. clearly shows two fingers 22g that practically occupy an entire section of an end of the body. Regarding Figure 16, Feingold et al. state that paddles 22n can be separate. Paddles or fingers 22g or 22n can be compressed inwardly or "brought together" to form a cylinder that substantially occupies an entire cross section of an end of the body when plunger 18 approaches the end of the cylindrical portion 12a and enters the conical portion 12b (see Fig. 4 and col. 9, lines 25-34).

Allowable Subject Matter

Claims 6, 10, 19 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anuadha Lamara*
March 30, 2005



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